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rotor bars formed of a material and having at least one first internal conduit formed in the material; and

circulation means for establishing a coolant circulation through the first internal conduit.

C2

--28. (New) A rotating machine comprising:

a rotating shaft;

a plurality of conductive rotor bars spaced from the rotating shaft and fixed thereto through at least one intermediate member, the plurality of conductive rotor bars having an exterior surface defining an outer periphery, at least one of the plurality of conductive rotor bars having at least one first internal conduit formed within the outer periphery; and

circulation means for establishing a coolant circulation through the first internal conduit.--

#### REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, Applicants would like to thank the Examiner for maintaining the indication that Claims 3, 6, 11-15, 18, 19, and 21 contain allowable subject matter and for also indicating claim 27 as being allowed.

However, the Examiner also maintains the rejections of the remaining claims under 35 U.S.C. §§ 102(b) and 103(a). Specifically, the Examiner rejects claims 1, 9, and 20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,488,532 to Endress et al. (hereinafter "Endress"). Additionally, the Examiner rejects claims 2, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Endress in view of U.S. Patent No. 3,800,174 to

Butterfield et al. (hereinafter "Butterfield"). Furthermore, the Examiner rejects claims 4, 5, and 10 under 35 U.S.C. § 103(a) as being unpatentable over Endress in view of U.S. Patent No. 4,728,840 to Newhouse (hereinafter "Newhouse"). Still further, the Examiner rejects claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Endress in view of U.S. Patent No. 3,629,628 to Rank et al. (hereinafter "Rank"). Lastly, the Examiner rejects claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Endress in view Rank and further in view of U.S. Patent No. 5,980,650 to Belt et al. (hereinafter "Belt").

In response, claim 1 has been amended to clarify its distinguishing features.

The Examiner argues that column 2, lines 55-60 of Endress discloses the tubular member (33) being "embedded" in the conductive bars (35) and that an integral unit does not have to be formed from a unitary member. Therefore, claim 1 has been amended to clarify that the internal conduit is formed in the rotor bar itself, rather than in separate tubular member, as is shown in Endress. Specifically, claim 1, as amended, recites that the rotor bar is **formed of a material** and has at least one first internal conduit **formed in the material**. The amendment to claim 1 is fully supported in the original disclosure, particularly in the drawings. Thus, no new matter has been entered by way of the present amendment to claim 1.

With regard to the rejection of claims 1, 9, and 20, under 35 U.S.C. § 102(b), a rotating machine having a plurality of conductive rotor bars, at least one of which **being formed of a material** and having at least one internal conduit **formed in the material**, as claimed in amended independent claim 1, is nowhere disclosed in Endress. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of

each and every element of the claimed invention, arranged as in the claim,"<sup>1</sup> independent claim 1 is not anticipated by Endress. Accordingly, independent claim 1 patentably distinguishes over Endress and is allowable. Claims 9 and 20 being dependent upon claim 1 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 9, and 20 under 35 U.S.C. § 102(b).

With regard to the rejections of claims 2, 4, 5, 7, 8, 10, 16, and 17 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 2, 4, 5, 7, 8, 10, 16, and 17 are allowable therewith because they depend from an allowable base claim.

In other words, independent claim 1 is not rendered obvious by the cited references because neither the Endress patent, nor the Butterfield patent, nor the Newhouse patent, nor the Rank patent, nor the Belt patent, whether taken alone or in combination, teach or suggest a rotating machine having a plurality of conductive rotor bars, at least one of which **being formed of a material** and having at least one internal conduit **formed in the material**. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 2, 4, 5, 7, 8, 10, 16, and 17, being dependent upon claim 1 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 2, 4, 5, 7, 8, 10, 16, and 17 under 35 U.S.C. § 103(a).

Lastly, new claim 28 has been added in which the conductive rotor bars are recited as having **an exterior surface which defines an outer periphery** and that the internal conduit is formed **within the outer periphery**. New claim 28 is fully supported in the

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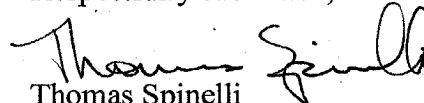
<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

original disclosure, particularly in the drawings. Thus, no new matter has been entered by way of the addition of new claim 28.

Attached hereto is a marked-up version of the changes made to the application by the current amendment. The attached page is captioned **"Version with Markings to Show Changes Made."**

The above amendments and remarks establish the patentable nature of all the claims currently in this case. Issuance of a Notice of Allowance and passage to issue of these claims are therefore respectfully solicited. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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Encl. (Version with Markings to Show Changes Made)

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**Claim 1 has been amended as follows:**

1. (Three Times Amended) A rotating machine comprising:

a rotating shaft;

a plurality of conductive rotor bars spaced from the rotating shaft and fixed thereto through at least one intermediate member, at least one of the plurality of conductive rotor bars formed of a material and having at least one first internal conduit [integrally] formed [therein] in the material; and

circulation means for establishing a coolant circulation through the first internal conduit.